

The opinion in support of the decision being  
entered today is not binding precedent of the Board.

Paper 38

Filed by: Richard E. Schafer  
Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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BERND STILLER

Junior Party,  
(U.S. Application 09/101,663),

v.

HANS HEID and JEROME SEJOURNET  
**(Microm International Gmbh)**

Senior Party  
(U.S. Patent 5,895,628).

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Patent Interference No. 105,044

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**DECISION ON JOINT MOTION FOR NO INTERFERENCE-IN-FACT**

The parties have filed a joint motion under 37 CFR § 1.633(b) for judgment of no interference-in-fact. The motion is denied without prejudice to refiling the motion within 21 days of this decision.

An “interference-in-fact” is a term of art in interference practice. The rules define an “interference-in-fact” as follows (37 CFR § 1.601(j)):

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

The rules define “same patentable invention” and “separate patentable invention” as follows (37 CFR § 1.601(n)):

Invention “A” is the same patentable invention as an invention “B” when invention “A” is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention “B” assuming invention “B” is prior art with respect to invention “A”. Invention “A” is a separate patentable invention with respect to invention “B” when invention “A” is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention “B” assuming invention “B” is prior art with respect to invention “A”.

Subparts (j) and (n) of Rule 601 implement holdings of the former Court of Customs and Patent Appeals. See, e.g., Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977) (an interference-in-fact held to exist between a claim to a method of using cyclopentadiene and a claim to a method using butadiene, isoprene, dimethylbutadiene, piperylene, anthracene, perylene, furan or sorbic acid; the claims were held to be directed to the same patentable invention even though they did not overlap in scope). See also Notice of Final Rule, Patent Interference Cases, 49 Fed. Reg. 48416 (Dec. 12, 1984) (see Examples 16 at 48421 and Example 20 at 48424).

An issue of whether an interference-in-fact exists is placed before the board by the filing of a preliminary motion under 37 CFR § 1.633(b). If the preliminary motion is granted, both parties would be entitled to a patent containing their respective claims initially designated as corresponding to the count because those claims would be determined to be directed to separate patentable inventions.<sup>1</sup>

Resolution of an interference-in-fact issue involves a two-way unpatentability analysis. The claimed invention of Party A is presumed to be prior art vis-a-vis Party B and vice versa. The claimed invention of Party A must anticipate or render obvious the claimed invention of Party B and the claimed invention of Party B must anticipate or render obvious the claimed invention of Party A. When the two-way analysis is applied, then regardless of who ultimately prevails on the issue of priority, the Patent and Trademark Office (**PTO**) assures itself that it will not issue two patents to the same patentable invention.

The declaration of an interference raises a rebuttable presumption that an interference-in-fact exists between the parties’ claims. A party filing a preliminary motion under 37 CFR § 1.633(b) has

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<sup>1</sup> See Notice of Final Rule, 49 Fed. Reg. at 48440 (“Two comments questioned the nature of the judgment when a motion under § 1.633(b) is granted. Section 1.633(b) authorizes the filing of a [preliminary] motion for judgment on the ground that there is no interference-in-fact. If a [preliminary] motion under § 1.633(b) is granted, the judgment would provide that each party is entitled to a patent containing that party’s claims corresponding to the count.”)

the burden of proof. 37 CFR § 1.637(a). That burden can be met by establishing, prima facie, that the party is entitled to the relief requested. The fact that a preliminary motion is effectively unopposed does not relieve the parties of meeting the burden of establishing that they are prima facie entitled to relief. In this case, the parties have filed a joint motion so the burden rests on both parties.

A preliminary motion for a judgment of no interference-in-fact must establish that “two-way” patentability is lacking, i.e., that none of the claims of one party which correspond to the count are the same patentable invention as the opponent’s claims corresponding to the count. In terms § 1.601(n), it must be establish that all of the claims of one party are new and non-obvious when the opponents claims are taken as prior art.

Section 1.601(n) incorporates the obviousness standard of 35 U.S.C. § 103. Thus, in making a determination as to whether one claim is directed to the same patentable invention as another, all the considerations necessary in reaching a conclusion as to obviousness *vel non* come into play. Obviousness is a legal conclusion based on the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. This conclusion is reached from the perspective of the hypothetical person having ordinary skill in the art who presumed to be aware of all the pertinent prior art. Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454, 227 USPQ 293, 297 (Fed. Cir. 1985). Thus, the evaluation of obviousness is not made in a vacuum, but requires consideration of the pertinent prior art and level of ordinary skill in the art.

In typical situations involving obviousness, such as ex parte examination or a civil action for patent infringement, the burden is on the party asserting that the claimed subject matter would have been obvious. This burden is a positive one which may be carried by submitting evidence including prior art references which serves to delineate the scope and content of the prior art, the level of skill in the art and the differences between the claimed subject matter and the prior art. In the typical obviousness scenario a single prior art reference, “the primary reference,” is used as a basis for determining differences. The primary reference is also evidence of the scope and content of the prior art and the level of ordinary skill in the art. Other evidence including additional or “secondary references” are relied upon to further delineate the scope and content of the prior art and the level of ordinary skill in the art.

The situation involving a preliminary motion for judgment of no interference-in-fact is different. The moving party bears the burden of proof and must establish a negative—that the claims of one party are non-obvious from the subject matter of the opponent’s claims when each of the opponent’s claims is treated as prior art. 37 CFR §§ 1.601(j) and 1.601(n). In the analysis for no interference-in-fact, the claims of one party become the primary references. A comparison of the “primary references” with the opponent’s claims delineates the differences. Once the differences are identified the movant must establish that the differences do not render the opponent’s claimed subject matter as a whole obvious in light of the scope and content of the prior art and the level of ordinary skill in the art<sup>2</sup>.

This burden placed upon the movant by 37 CFR § 1.637(a) could be construed to require proof that there is no prior art that when combined with the opponent’s claims would render the party’s subject matter as a whole obvious. This burden would be unreasonable and is most likely impossible to meet. It would also be inconsistent with 37 CFR § 1.601 which provides that the rules should be construed to secure the just, speedy and inexpensive determination of interferences. However, the obviousness determination must be made from the perspective of the hypothetical person of ordinary skill who is presumed to have knowledge of all the pertinent prior art. Thus, consideration of the prior art and the level of ordinary skill in the art can not be totally avoided. Therefore, a movant must provide some evidentiary basis for consideration of the obviousness of the invention in light of the scope and content of the prior art and the level of ordinary skill in the art. This might be done by testimony of a person skilled in the particular art (such as an inventor) that he is unaware of any prior art or other reasons that would teach or suggest modifying the subject matter of the opponent’s claims to account for the differences. The “other reasons” would include knowledge that any modifications necessary to the opponent’s claims do not reflect conventional or routine practices or other matters well known in the art. This standard applies to both opposed and unopposed motions.

Where the evidence is sufficient, the movant will have established a prima facie case. Where the burden of proof is met by the movant and the motion is opposed, the burden of production and

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<sup>2</sup> The consideration of the scope and content of the prior art, of course, may be side-stepped by proving one or more of the secondary considerations of non-obviousness. However, that was not the approach taken here.

persuasion would be shifted to the opponent. The opponent could meet this burden by submitting evidence which could include prior art references which would show that the movant's claimed subject matter as a whole would be obvious notwithstanding any differences.

The parties jointly move for a ruling of no interference-in-fact. Their motion points out that none of Stiller's involved claims are identical to any of Heid's involved claims. The parties also point out that Heid's claims include limitations not present in any of Stiller's claims. The motion further identifies certain benefits said to flow from the limitations. The parties then argue that the limitations are not "recited or suggested" by Stiller's claims and would, therefore, be both novel and non-obvious.

The parties support their position by the joint declaration testimony of Hans Heid and Helmut Goldbecker. Exhibit 1001. The testimony parallels the parties' motion in identifying certain limitations not present in Heid's claims and then testify that, based upon their knowledge and experience none of the Stiller claims recite or suggest the limitations present in Heid's claims.

The parties have failed to establish that they are prima facie entitled to a ruling of no interference-in-fact. The arguments and testimony focus only on a comparison of the subject matter of Heid's and Stiller's claims. The parties have not provided evidence related to the scope and content of the prior art or the level of ordinary skill in the art. Merely comparing a party's claims with the opponents and identifying differences without providing evidence relating to the scope and content of the prior art and the level of ordinary skill in the art does not meet the burden of establishing prima facie non-obviousness. See Aelony, 547 F.2d 566, 192 USPQ 486 (CCPA 1977). Thus, the declaration does not establish that the declarants are unaware of any basis in the prior art or level of skill in the art that would suggest modifying the subject matter of Stiller's involved claims.

The parties' preliminary motion for no interference-in-fact is denied without prejudice to submitting a renewed motion with additional evidence within 21 days of this order.

Richard E. Schafer  
Administrative Patent Judge

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